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Mailed: December 2, 2003

Paper No. 10
BAC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Boise Cascade Corporation

Serial No. 76363146

Kevin M. Hayes of Klarquist Sparkman, LLP for Boise Cascade Corporation.

Alex S. Keam, Trademark Examining Attorney, Law Office 114
(K. Margaret Le, Managing Attorney).

Before Simms, Chapman and Bucher, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

On January 24, 2002, Boise Cascade Corporation (a Delaware corporation, with a corporate address in Boise, Idaho) filed an application to register on the Principal Register the mark BOISE ALLBEAM for "laminated wood members" in International Class 19. The application is based on applicant's assertion of a bona fide intention to use the mark in commerce.

Registration has been finally refused under Section 6 of the Trademark Act on the basis of applicant's failure to comply with a requirement to disclaim the word "Boise." Such word, according to the Examining Attorney, is primarily geographically descriptive of applicant's goods within the meaning of Section 2(e)(2) of the Trademark Act, 15 U.S.C. §1052(e)(2), and therefore must be disclaimed.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested.

It is the Examining Attorney's position that the primary significance of the term "Boise" is that of a geographic place, specifically, a city in Idaho, as evidenced by the following definition in The American Heritage Dictionary (Third edition 1992): "The capital and largest city of Idaho, in the southwest part of the state on the Boise River, about 257 km (160 mi) long. The city was founded in 1863 after gold was discovered in the river valley. Population, 102,160."

In addition to this definition, the Board takes judicial notice of the following definitions of "Boise" (emphasis added):¹

¹ See *The University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d

- (1) "city (1990 pop. 125,738) (Capital of Idaho) ... The largest city in Idaho, with one of the fastest growing metropolitan areas in the U.S., Boise is a RR junction and an important trade and transportation center. Mfg. (food processing, *paper and wood prods.*, computer hardware and software, specialty semiconductors and electronics.)" The Columbia Gazetteer of North America (2000); and
- (2) "also, Boise City, pop. 125,738) state capital and seat of Ada Co., SW Idaho, on the Boise R. Situated on the Oregon Trail, it was founded in 1863 after the Boise Basin gold rush, when the U.S. Army built Fort Boise. The settlement was at first a service center for nearby mines. Later the economy expanded to include agriculture and *lumbering*. ... Surrounded by a large metropolitan area, Boise is by far the most populous city in Idaho, with a population growth of 25% between 1980 and 1990. ... The city is also a trade center for a large area of farms Other industries include *lumber milling*, food products, and the manufacture of electronic equipment, mobile homes, *wood and steel products*, and farm machinery." The Cambridge Gazetteer of the United States and Canada (1995).

The Examining Attorney contends that "Boise" names a geographical place that is not remote or obscure; and that

1372, 217 USPQ 505 (Fed. Cir. 1983). See also, TBMP §704.12(a) (2d ed. June 2003).

because applicant's goods come from the geographical place named in the mark, a public association of the goods with the place is presumed.

Applicant argues, inter alia, that the Examining Attorney has not made a prima facie case that BOISE ALLBEAM is primarily geographically descriptive in relation to the goods;² that the Examining Attorney is required to establish a goods/place association; that even if the Examining Attorney had established a prima facie case, applicant's evidence establishes that the primary significance of BOISE for laminated wood members to consumers is not geographic, but rather, it is applicant as the source of the goods; that applicant has applications for marks on the Principal Register and registrations of marks on the Principal Register which do not include a disclaimer of "Boise" or a Section 2(f) claim of acquired distinctiveness; and that doubt regarding whether a term is primarily geographically descriptive is resolved in applicant's favor.

Both the Examining Attorney and applicant put into the record photocopies of some of applicant's related applications and registrations. Applicant emphasizes the

² The Examining Attorney required a disclaimer of the term "Boise." She did not refuse registration of the entire mark BOISE ALLBEAM on the basis that it is primarily geographically descriptive.

few wherein the term "Boise" has not been disclaimed, or is not under Section 2(f) on the Principal Register. The Examining Attorney emphasizes those wherein the term "Boise" is disclaimed, or is under Section 2(f) on the Principal Register, or is registered on the Supplemental Register.

Applicant submitted with its brief on appeal numerous exhibits (A-P), and the declaration of Susan Walton, applicant's director of corporate communications. Only some of the exhibits were previously of record. With regard to the remainder of the exhibits, as well as the declaration of Susan Walton, normally material submitted for the first time with applicant's brief would be excluded as untimely submitted. See Trademark Rule 2.142(d), and TBMP §1207.01 (2d ed. June 2003). However, in this case, the Examining Attorney did not object thereto, and, in fact, she discussed the evidence, treating it as if it was of record. See TBMP §1207.03 (2d ed. June 2003). Accordingly, the Board considers applicant's evidence stipulated into the record.

In order for a mark, or a portion thereof, to be considered primarily geographically descriptive under Section 2(e)(2) of the Trademark Act, it is necessary to show (i) that the mark or relevant portion is the name of a

place known generally to the public, and (ii) that the public would make a goods (or services)/place association, that is, believe that the goods (or services) for which the mark is sought to be registered originate or will originate in the named place. See *In re Jacques Bernier Inc.*, 894 F.2d 389, 13 USPQ2d 1725 (Fed. Cir. 1990); *In re Societe General des Eaux Minerals de Vittel S.A.*, 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987); *In re JT Tobacconists*, 59 USPQ2d 1080 (TTAB 2001); and *In re California Pizza Kitchen, Inc.*, 10 USPQ2d 1704 (TTAB 1988). Moreover, where there is no genuine issue that the geographical significance of a term is its primary significance, and where the geographical place named is neither obscure nor remote, a public association of the goods and/or services with the place may ordinarily be presumed from the fact that the applicant's goods and/or services come from or will come from the geographical place named in the mark. See, e.g., *In re Carolina Apparel*, 48 USPQ2d 1542 (TTAB 1998); *In re California Pizza Kitchen, Inc.*, supra; and *In re Handler Fenton Westerns, Inc.*, 214 USPQ 848 (TTAB 1982).

The dictionary definitions establish a prima facie case that the primary significance of the term "Boise" is geographic. Being a specifically defined, relatively large city in the United States and a state capital, it is

neither remote nor obscure in the context of consumer awareness. Considering the first part of the test, we find the evidence clearly establishes that "Boise" is the name of a place known generally to the public.

This leads to a consideration of the second part of the test, and here the goods/place association is presumed because applicant is a corporation located in Boise, Idaho, and applicant acknowledges that its "goods originate from many different places including Boise, Idaho." The fact that applicant may manufacture goods at locations other than Boise, Idaho does not mean that the public would not associate applicant's "laminated wood members" with Boise, Idaho. See *In re Chalk's International Airlines Inc.*, 21 USPQ2d 1637 (TTAB 1991).

Even if the goods/place association were not presumed, it is established on this record by the gazetteer entries showing that Boise, Idaho is known for lumber milling and wood products. Moreover, applicant's own evidence (Exhibit B) shows that it was founded in 1957 by the merger of two Northwestern lumber companies, Boise Payette Lumber Company of Boise, Idaho and Cascade Lumber Company of Yakima, Washington into Boise Cascade Corporation; and that applicant is now and always has been headquartered in Boise, Idaho. Thus, the record establishes that it is

reasonable for consumers to assume that the involved goods will come from Boise, Idaho.

In sum, the term "Boise" is a geographic term which is neither obscure nor remote; the goods come from the place named; and the place is known for the goods involved herein. Cf. *Trans Continental Records Inc.*, 62 USPQ2d 1541 (TTAB 2002). Because both parts of the enunciated test have been met, we find that the term "Boise" is primarily geographically descriptive. See *In re Compagnie Generale Maritime*, 993 F.2d 841, 26 USPQ2d 1652 (Fed. Cir. 1993.)

As noted above, the Examining Attorney points out that there are several applications/registrations owned by applicant in which it has disclaimed the term BOISE or has registered marks including the term under Section 2(f) or on the Supplemental Register, while applicant contends that it has "registrations and allowed applications on the Principal Register that do not disclaim the term BOISE and that were not registered on the Supplemental Register." (Emphasis in original, brief, p. 13). While the USPTO strives for consistency, the Board must decide each case on its own facts and record. See *In re Consolidated Foods Corp.*, 200 USPQ 477 (TTAB 1978). With respect to applicant's applications and/or Principal Register registrations which do not include disclaimers of the term

"Boise" or a claim of acquired distinctiveness under Section 2(f), we do not have before us any information from the involved files as to why an Examining Attorney did not require such, or dropped any such requirement, and we can only speculate thereon. See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001). Thus, these applications/registrations are of little probative value.

However, applicant's previous registrations (and applications) on the Supplemental Register, or under Section 2(f) on the Principal Register, or including a disclaimer of "Boise" are more probative as they evidence applicant's acknowledgment that the term "Boise" is primarily geographically descriptive of the goods and/or services involved therein. (See e.g., application Serial No. 76358793 for the mark BOISE for, inter alia, "wood pulp for manufacturing purposes, paper pulp for manufacturing purposes" and "wood and wood products" was recently approved for publication under Section 2(f) of the Trademark Act by the Examining Attorney; application Serial No. 76362590 for the mark BOISE GLULAM ("glulam" disclaimed) for "laminated wood beams" was recently published for opposition under Section 2(f) of the Trademark Act; Registration No. 2677231 for the mark BOISE CLASSIC for "high grade lumber" issued January 21, 2003

pursuant to Section 2(f) of the Trademark Act as to "Boise"; Registration No. 2575790 for the mark BOISE GOLD for "high-grade lumber" issued June 4, 2002 with a disclaimer of the term "Boise"; Registration No. 2279010 for the mark BOISE for distributorship and other services in the fields of, inter alia, office and computer supplies issued September 21, 1999 pursuant to Section 2(f) of the Trademark Act; Registration No. 2542099 for the mark BOISE EXPRESS for distributorship and other services in the fields of office supplies and office furniture issued February 26, 2002 pursuant to Section 2(f) of the Trademark Act; and Registration No. 2407393 for the mark BOISE MARKETING SERVICES ("marketing services" disclaimed) for distributorship and other services in the field of promotional merchandise and promoting the business of others issued August 7, 2000 on the Supplemental Register.)

Finally, we are aware that applicant contends the mark is not "primarily" geographical because its primary significance to the consuming public is to identify applicant as the source of the goods. Applicant submitted evidence relating thereto, including information such as sales figures, the costs involved in recently changing applicant's trade name (not its legal name), and several press releases issued by applicant. However, the record is

clear that applicant has not sought to invoke the benefits of Section 2(f) of the Trademark Act regarding a claim of acquired distinctiveness of the word "Boise" for the goods in this application. While this evidence would have been relevant to the issue of acquired distinctiveness, that issue is not involved herein. See *In re Cazes*, 21 USPQ2d 1796 (TTAB 1991); and *In re McDonald's Corp.*, 230 USPQ 304 (TTAB 1986) (both cases involve the necessity of claims of acquired distinctiveness and surname refusals).

Decision: The requirement under Section 6 for a disclaimer of the term "Boise" is proper, and the Examining Attorney's refusal to register the mark in the absence of a disclaimer of "Boise" is affirmed.

If a disclaimer is entered within thirty days from the mailing date hereof, this decision will be set aside and the application file will then be forwarded for publication of the mark for opposition. See Trademark Rule 2.142(g).